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Yuzhong Shen

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EXAMINER

LEE, ANDREW CHUNG CHEUNG

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/748,286

Applicant(s)

SHEN, YUZHONG

Examiner

Andrew C Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-22-2000.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the labeled rectangular box(es) with S21, S22, S23, S24, S25, S26, S27, S28 and S29 for Fig.2 and S31, S32 and S33 for Fig. 3 shown in the drawings should be provided with descriptive text or legends. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The abstract of the disclosure is objected to because undue length. The abstract should be a brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

- Pages 1 to 17 for Specification, pages 1 to 6 for the Claims, and page 1 for the Abstract, line numbering should be incorporated in each page, or the paragraphs of the specification or Claims or Abstract should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (e.g. [0001]).
- Page 1 of the Claims, the title is not required. And the "Patent Claims" should be corrected as "I (or we) claim:" or "What is claimed is:" — while there is not set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I(or we) claim, ""The invention claimed is".
- Page 2, line 19, the term "Internetaddress" should have a space between Internet and address". Correction is required.
- Page 1 of the Abstract, the title is not required.

Appropriate correction is required.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claimed subject matter in Claim 5 “as a function of charges incurred on the telephone network (PSTN) for the establishment of the links (VA1, VGW1) of the connection (VA1, VGW1, VB1) between the telephone-network terminal (TELA) and the Internet gateway (GW1).” is not disclosed in the specification. Referring to Claim 7, Page 3, line 5, the claimed subject matter “first receiving means (TRSW)”; Page 4, line 3, the claimed subject matter “recognition means (CPUSW)”; Page 4, line 7, the claimed subject matter “sending means (TRSP)”; Page 4, line 13, the claimed subject matter “second receiving means (TRSP)”; Page 4, line 18, the claimed subject matter “call setup means (TRSW)”; Page 4, lines 24 – 25, the claimed subject matter “second sending means (TRSW)” are not disclosed as what is described in the specification. Referring to Claim 8, Page 4, line 6 of Claim 8, the claimed subject matter “receiving means (TRSC)”; Page 5, line 3, the claimed subject matter “sending means (TRSC)” are not disclosed as what is described in the specification. Referring to Claim 9, Page 5, line 6 of Claim 9, the claimed subject matter “call setup means (TRGW)”; Page 5, line 14, the claimed subject matter “call setup means (TRGW1)” are not disclosed as what is described in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhang et al. (U.S. Patent No. 6661785 B1).

Regarding Claim 1, Zhang et al. discloses the limitation of establishing a connection between a telephone-network terminal (TELA), connected to a telephone network (PSTN) designed as an intelligent network, and an Internet terminal (TERB), connected to the Internet (INT) (Fig. 1a; Fig. 1b; column 4, lines 10 – 13), characterized by the following steps: The telephone network (PSTN) receiving from the telephone-network terminal (TELA) a request for a connection to a subscriber number assigned to the Internet terminal (TERB) (column 1, line 67; column 2, lines 1 – 2); - the telephone network (PSTN) routing the connection request to a service switching point (SSP) (Fig. 1a; column 3, lines 3 – 9); the service switching point (SSP) determining that the connection request is to be treated as a connection request to an intelligent network (Fig 1a; column 3, lines 7 – 9); the service switching point (SSP)

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transmitting to a service control point (SCP) a service request message requesting a service for handling the request for the connection to the subscriber number assigned to the Internet terminal (TERB) (column 8, lines 38 –43); the service control point (SCP) determining an Internet address of the Internet terminal (TERB) assigned to the subscriber number (column 4, line 20; lines 40 – 42, lines 53 – 54); the service control point (SCP) transmits to the service switching point (SSP) a service message with the Internet address of the Internet terminal (TERB) (column 8, lines 62 – 64); the service switching point (SSP) establishes a connection through the telephone network (PSTN) to a (first) Internet gateway (GW1) via which the connection between the telephone-network terminal (TELA) and the Internet terminal (TERB) can be established (column 8, lines 38 – 43; column 9, lines 33 – 38); the service switching point (SSP) sends the Internet address of the Internet terminal (TERB) to the (first) Internet gateway (GW1) (column 10, lines 34 – 39); and the Internet gateway (GW1) establishes the link (VB1) of the connection between the telephone-network terminal (TELA) and the Internet terminal (TERB) via the Internet (INT) using the Internet address of the Internet terminal (TERB) (column 13, lines 26 – 33; lines 41 – 44).

Regarding Claim 2, Zhang et al. discloses the limitation of characterizing in that in addition to the Internet address of the Internet terminal (TERB), the service control point (SCP) determining the address of the (first) Internet gateway (GW1) (column 8, lines 59 – 64; column 10, lines 24 – 30), and that the service control point (SCP) transferring the address of the (first) Internet gateway (GW1) to the service switching

point (SSP) for establishing the connection to the Internet gateway (GW1) (column 10, lines 31 – 39).

Regarding Claim 3, Zhang et al. discloses the limitation of characterizing in that the (first) Internet gateway (GW1) or the Internet terminal (TERB) transfers the Internet address of the Internet terminal (TERB) to the service control point (SCP) for storage in conjunction with the subscriber number of the Internet terminal (TERB) (column 11, lines 58 – 67).

Regarding Claim 4, Zhang et al. discloses the limitation of characterizing in that the service control point (SCP) determining the Internet address of the Internet terminal (TERB) from a table in which the address of the Internet terminal (TERB) is associated with a Universal Personal Telecommunications service number (column 11, lines 62 – 65).

Regarding Claim 5, Zhang et al. discloses the limitation of characterizing in that the service control point (SCP) determining the address of the (first) Internet gateway (GW1) as a function of a loading of communication paths of the telephone network (PSTN) or as a function of charges incurred on the telephone network (PSTN) for the establishment of the links (VA1, VGW1) of the connection (VA1, VGW1, VB1) between the telephone-network terminal (TELA) and the Internet gateway (GW1) (column 4, lines 22 – 28; column 8, lines 59 – 61).



Regarding Claim 6, Zhang et al. discloses the limitation of characterizing in that the service control point (SCP) determining an address of at least a second Internet gateway (GW2) and transfers the address of the first Internet gateway (GW1) and the address of the at least second Internet gateway (GW2) to the service switching point (SSP) (Fig. 3, column 14, lines 2 – 14).

Regarding Claim 7, Zhang et al. discloses the limitation of a service switching point (SSP) for establishing a connection between a telephone-network terminal (TELA), connected to a telephone network (PSTN) designed as an intelligent network, and an Internet terminal (TERB), connected to the Internet (INT) ( Fig. 1a; Fig. 1b; column 4, lines 10 – 13), the service switching point (SSP) comprising first receiving means (TRSW) designed to enable the service switching point (SSP) to receive from the telephone-network terminal (TELA) a request for a connection to a subscriber number assigned to the Internet terminal (TERB) (column 1, line 67; column 2, lines 1 – 2), characterizing in that the service switching point (SSP) further comprising recognition means (CPUSW) designed to enable the service switching point (SSP) to recognize that the connection request is to be treated as a connection request to an intelligent network (column 8, lines 10 – 15), in that the service switching point (SSP) further comprises first sending means (TRSP) designed to enable the service switching point (SSP) to send to a service control point (SCP) a service request message requesting a service for handling the request for the connection to the subscriber number assigned to the Internet terminal (TERB) (column 3, lines 29 – 31), in that the service switching point (SSP) further comprises second receiving means (TRSP)

designed to enable the service switching point (SSP) to receive from the service control point (SCP) a service message with the Internet address of the Internet terminal (TERB) (column 4, lines 40 – 42), in that the service switching point (SSP) further comprising call setup means (TRSW) designed to enable the service switching point (SSP) to set up a call through the telephone network (PSTN) to a (first) Internet gateway (GW1) via which the connection between the telephone-network terminal (TELA) and the Internet terminal (TERB) can be established (column 7, lines 54 – 57; column 8, lines 10 – 12), and in that the service switching point (SSP) further comprising second sending means (TRSW) designed to enable the service switching point (SSP) to send the Internet address of the Internet terminal (TERB) to the Internet gateway (GW1) (column 8, lines 13 – 18; lines 38 – 43).

Regarding Claim 8, Zhang et al. discloses the limitation of a service control point (SCP) for establishing a connection between a telephone-network terminal (TELA), connected to a telephone network (PSTN) designed as an intelligent network (column 2, lines 49 – 51; lines 66 – 67; column 3, line 1), and an Internet terminal (TERB), connected to the Internet (TNT) (Fig. 1a, column 4, lines 22 – 25), characterizing in that the service control point (SCP) comprising receiving means (TRSC) designed to enable the service control point (SCP) to receive from a service switching point (SSP) a service request message with which the service switching point (SSP) requests a service for handling a request for a connection to a subscriber number assigned to the Internet terminal (TERB) (column 4, lines 22 – 25; lines 40- 42), in that the service control point (SCP) further comprising means (CPUSC, MEMSC) designed to enable the service

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control point (SCP) to determine an Internet address of the Internet terminal (TERB) assigned to the subscriber number (column 3, lines 3- 6), and in that the service control point (SCP) further comprising sending means (TRSC) designed to enable the service control point (SCP) to send to the service switching point (SSP) a service message with the Internet address of the Internet terminal (TERB) (column 3, lines 3- 6; column 4, lines 40 – 42).

Regarding Claim 9, Zhang et al. discloses the limitation of an Internet gateway (GW1) for establishing a connection between a telephone-network terminal (TELA), connected to a telephone network (PSTN) designed as an intelligent network, and an Internet terminal (TERB), connected to the Internet (INT) (Fig. 1a, column 4, lines 22 – 25), the Internet gateway (GW1) comprising call setup means (TRGW) designed to enable the Internet gateway (GW1) to set up a call between the telephone-network terminal (TELA) and the Internet terminal (TERB) (column 4, lines 25 – 28), characterizing in that the Internet gateway (GW1) further comprising receiving means (TRGW1) designed to enable the Internet gateway (GW1) to receive an Internet address of an Internet terminal (TERB) from a service switching point (SSP) (column 4, line 67; column 5, lines 1 –2), and that the call setup means (TRGW1) are further designed to enable the Internet gateway (GW1) to set up the connection between the telephone-network terminal (TELA) and the Internet terminal (TERB) using the Internet address of the Internet terminal (TERB) (column 5, lines 31 – 39).

Regarding Claim 10, Zhang et al. discloses the limitation of a program module for an Internet terminal (TERB) for establishing a connection between a telephone-network terminal (TELA) (column 9, lines 48 – 53), connected to a telephone network (PSTN) designed as an intelligent network (column 2, lines 49 – 51), and an Internet terminal (TERB), connected to the Internet (INT) (Fig. 1b, Fig. 3, column 8, lines 47- 51), the program module comprising program code, which can be executed by a control means of the Internet terminal (TERB) (column 9, lines 48 – 54), and detection means designed to enable the program module to determine that the Internet terminal (TERB) is connected to the Internet (INT) within a Internet session and which Internet address is assigned to the Internet terminal (TERB) for this session (column 9, lines 48 – 50), characterized in that: the program module further comprises sending means designed to enable the program module to send a message with the Internet address, together with a subscriber number assigned to the Internet terminal (TERB) (column 9, lines 53 – 54; column 10, lines 24 – 26), to a service control point (SCP) of the telephone network (PSTN) (column 10, lines 28 – 30), so that the service control point (SCP) of a service switching point (SSP) can send a service message with the Internet address of the Internet terminal (TERB) when the service switching point (SSP) requests a service for handling a request for a connection to the subscriber number assigned to the Internet terminal (TERB) (column 10, lines 31 – 40).

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (U.S. Patent No. 6661785 B1) in view of Jones et al. (U.S. Patent No. 6141341).

Regarding Claim 11, Zhang et al. discloses the limitation of an Internet terminal (TERB) (Fig. 1a, column 1, lines 25 – 27), he fails to disclose explicitly comprising memory means (MEMTR) in which a program module is stored, and further comprising control means (CPUTR) designed to enable the Internet terminal (TERB) to execute program code of the program module. Jones et al. discloses the limitation of memory means (MEMTR) in which a program module is stored (column 3, lines 25 – 27), and further comprising control means (CPUTR) designed to enable the Internet terminal (TERB) to execute program code of the program module (column 3, lines 30 – 34). It would have been obvious to modify Zhang et al. to include a memory means (MEMTR) in which a program module is stored, and further comprising control means (CPUTR) designed to enable the Internet terminal (TERB) to execute program code of the program module such as that taught by Jones et al. in order to enable users to place and receive internet-based calls via the users existing equipment operating in its current fashion.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Lee whose telephone number is (571) 272-3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ACL 13 September 2004

  
Ajit Patel  
Primary Examiner